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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,599

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Bhavesh Mehta

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73/066

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05/12/2008

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/648,599

**Applicant(s)**

MEHTA ET AL.

**Examiner**

Jeffrey D. Carlson

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CS-100)  
Paper No(s)/Mail Date 2/25/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

This action is responsive to the paper(s) filed 2/13/2008.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 30-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

- The specification defines "computer-readable medium" as including statutory storage mediums such as optical or magnetic discs, yet also as including various forms of "transmission media" wave and/or signals, none of which are statutory for computer-readable storage medium claims. See MPEP 2106.01. Applicant should delete the transmission media from the specification so that these claims in their broadest reasonable interpretation do not cover such signals/waves as transmission media.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 29 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Applicant's disclosure is limited to selecting ads based on when ad contracts were formed. There is no disclosure regarding rules to follow or ignore when accepting or denying contracts. There is no disclosure found supporting the claim language that contracts are formed regardless of the impact. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**6. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

- Claim 38, it is unclear in what way the medium itself is being further defined. The medium of base claim 30 sets forth programming for determining which ads to include with the opportunity. Claim 38 describes an apparent limitation regarding how contracts are formed, yet it is unclear from the specification whether the formation of contracts is done in software or done manually. Therefore, it is not clear how if at all, the ad selection software is being further limited.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 21-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carruthers et al (US2002/0128904).**

9. Regarding claims 21, 23, 25, Carruthers et al teaches systems and methods for selecting an ad to include with a request for web content having an ad slot (i.e. ad opportunity), responsive to the content request [¶ 7, 8, 26, 76]. Carruthers et al provides a prioritized master list of ads which provides an order for the ads to be displayed [¶ 34]. Each ad has a delivery criteria that is compared to the slot attribute (for example, the type of user requesting the content – ¶ 38) at the time of the opportunity in order to determine a qualifying subset of ads from the prioritized master list. The ad chosen from the qualifying subset of the master queue is taken to be chosen based upon the sequence of the prioritized queue. Carruthers et al prioritizes the queue of ads based upon priority, a weighting indicating the number of impressions needed and based upon feedback from the system regarding which ads have been shown [¶ 34, 35]. Further, Carruthers et al states that new, proposed campaigns are analyzed and added to the system if they can be accommodated based on the expected ad inventory [¶ 8]. Carruthers et al therefore recognizes that the slot inventory is limited

and that all requesting advertisers cannot necessarily be satisfied. Carruthers et al put to use a well known concept of "first-come first served" in that the first advertisers to make ad campaign contracts with the system of Carruthers et al are more likely to be accepted and to get their ads shown by the system than latecomers. It would have been obvious to one of ordinary skill at the time of the invention to have given further improved treatment to early advertisers by employing such a well known "first come, first served" notion and included prioritization of the master list of scheduled ads based upon when the advertisers contracted with the system, by comparing stored contract dates among advertisers. In this manner, ad campaigns of late coming advertisers may be accepted into the system, but would be given lower priority (i.e. placed toward the end of the queue) than earlier-arriving advertisers and such latecomers could not steal ad opportunities from earlier-arriving advertisers, even if the latecomers had ad contracts which were more "behind schedule". Late-arriving advertisers would only be served if ad inventory (available slots) was plentiful enough to fully server the advertisers who came before them. This is consistent with Carruthers et al's disclosure that early adopters will be accommodated, yet late adopters will not. Further, it is pointed out that applicant's system merely lets those at the front of the line dictate how much is left for others behind them in line – much like the well known "first come, first served" approach.

10. Regarding claims 22, 28, Carruthers et al teaches that ads have delivery constraints such as maximum impressions or time between impressions [0039]. If this is the case, the ad is removed from the qualifying subset so that it is not showed for the

current opportunity. This is taken to provide a step of including only ads that are not on track to be satisfied and removing all ads whose constraint is "on-track" or has been met. Alternatively, Carruthers et al teaches that each ad has delivery obligations and that determinations are made regarding whether the ad is "on track" or not. Carruthers et al demotes ads if they are on-track or have already met their delivery goals by moving them towards the bottom of the queue [¶ 35]. Carruthers et al states that ads ahead of schedule (i.e. on-track) are "effectively shut-off" by being placed at the end of the queue. Although this is taken to be effectively removed from the list, it would have been obvious to one of ordinary skill at the time of the invention to have removed such ads from the list entirely in order to ensure only ads that are behind schedule are selected. Further, one of ordinary skill would have found it obvious to have created a subset of ads by either starting with an entire collection and eliminating ads that don't belong, or by merely building the subset by selectively including only ads that do belong. Either approach leads to the same, predictable result (the intended subset).

11. Regarding claims 24, Carruthers et al teaches that the ads are targeted to the users by matching metadata about the ads to the user's metadata (profile) [¶ 38 lines 4-5].

12. Regarding claims 26, Carruthers et al does not appear to specify or restrict the type of content requested to a particular format in order to include the specified advertising. Carruthers et al teaches that the ads can be banner ads or pop-up ads [¶ 15]. Carruthers et al further states that users can access files of various types via the Internet (text, images, video, etc) [¶ 20]. It would have been obvious to one of ordinary

skill at the time of the invention to have provided such advertising associated with any type of electronic content such as a video stream, or even a web page that includes an embedded video stream as is well known, so that advertisers can reach a wide audience and content providers can earn advertising revenue for a variety of pages.

13. Regarding claims 27, Carruthers et al teaches default or filler ads that are used when no other ads are applicable for that user/slot/opportunity. This is taken to be a teaching that when there are indeed targeted ads that qualify (i.e. ads in a first priority class), that the default ads (i.e. ads in the second priority class) are not to be considered for insertion. It would have been obvious to one of ordinary skill at the time of the invention to have excluded such default ads when the "normal" ads are available. One of ordinary skill would have found it obvious to have created a subset of ads by either starting with an entire collection and eliminating ads that don't belong, or by merely building the subset by selectively including only ads that do belong. Either approach leads to the same, predictable result.

14. Regarding claims 29, in the situation where there is a large quantity of advertising inventory, each advertiser would be accepted regardless of their negligible impact capacity. Therefore Carruthers et al meets the claim language. Further however and as stated above with reference to the independent claim:

It would have been obvious to one of ordinary skill at the time of the invention to have given further improved treatment to early advertisers by employing such a well known "first come, first served" notion and included prioritization of the master list of scheduled ads based upon when the advertisers contracted with the system, by comparing stored contract dates among advertisers. In this manner, ad campaigns of late coming advertisers may be accepted into the system, but would be given lower priority (i.e.



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placed toward the end of the queue) than earlier-arriving advertisers and such latecomers could not steal ad opportunities from earlier-arriving advertisers, even if the latecomers had ad contracts which were more "behind schedule". Late-arriving advertisers would only be served if ad inventory (available slots) was plentiful enough to fully server the advertisers who came before them.

The rejection finds it obvious to accept all latecoming advertisers, even where the capacity forecaster delivers news of unlikely meeting a latecomer's goals. The advertiser would understand that the system would not be giving them as much preferential treatment as the advertisers in front of them. It would have been obvious to one of ordinary skill at the time of the invention to have not denied any advertising contract based on delivery impact, because the capacity forecaster may actually be wrong. Denying a contract using an underestimated inventory would result in lost advertising sales and therefore it would have been obvious to one of ordinary skill at the time of the invention to have accepted all contracts.

15. Claims 30-38 are rejected with the same reasoning as claims 21-29.

### **Response to Argument**

16. Applicant argues that Carruthers et al fails to teach or suggest selecting an earlier contracted ad rather than a later contracted ad when the later contracted ad is more behind. As resolved by the Board, this feature is obvious given the disclosure of Carruthers et al. It would have been obvious to have used 1<sup>st</sup>-come, 1<sup>st</sup> served as part of the ad prioritization process (i.e. after and separate from the steps of actually forming the contracts).

17. Applicant argues that the priority class feature is not taught by Carruthers et al. Examiner disagrees for the reasons stated above in the rejection.

18. Applicant appears to be arguing the difference between filtering out elements that don't belong from a population to form a subset vs. creating the subset by only including

those that do belong. If there is any difference between these two they are obvious ways of achieving the same result. If a child wanted to collect dimes from a jar full of change, the child would find it obvious to root through the change and select only the dimes – or to start with the entire set of coins and remove the pennies, nickels and quarters. In fact, these concepts are so similar, applicant appears to be claiming both: Claim 22 says to select only ads not on track, while 28 says to filter out ads that are on track. Both result in a subset of ads that are “behind”.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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Primary Examiner  
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